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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,978	11/03/2003	Robin Haley Gustin	P69352	5034
40401 7590 07/25/2008 Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314				
EXAMINER NGUYEN, NGA B				
ART UNIT 3692		PAPER NUMBER		
NOTIFICATION DATE 07/25/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@hershkovitz.net
patent@hershkovitz.net

Office Action Summary

Application No.

10/699,978

Applicant(s)

GUSTIN ET AL.

Examiner

Nga B. Nguyen

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3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 16-20 and 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- Paper No(s)/Mail Date 12/17/07.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Election filed on April 4, 2008, which paper has been placed of record in the file.
2. Claims 8-15 and 21-28 are elected for consideration in this application.

Response to Arguments/Amendment

3. Applicant's election with traverse of Group II (claims 8-15 and 21-28) in the reply filed on April 4, 2008 is acknowledged. The traversal is on the grounds that the search for each group of invention is substantially the same and no undue or serious burden would be presented in concurrently examining Groups I, II and III. This is not found persuasive because Group I drawn to a banking machine for performing **cash transactions**, Group II drawn to a banking machine for performing **wire transfer of funds to a transferee**, Group III drawn to a banking machine for performing **paying bills through a bills payment network**. Therefore, there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter that requires **different fields of search (cash transactions, wire transfer, paying bills)**.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on December 17, 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8-15 and 21-28 are rejected on the ground of nonstatutory double patenting over claims 1-19 of U. S. Patent No. 6,012,048 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an automated banking system for receiving payment from a user and for wire transfer of funds to a transferee in a banking network, comprising: an automated machine having a card receiver, an input device to enter the amount to be transferred to another, a keypad to enter the identity of the transferee's account, a payment acceptor for accepting payment by the user for the wire transfer, a verifier to verify that the transferee has an account in the banking network, a communication system having a modem in the banking network for wire transfer through the banking network to the verified transferee's account, etc...

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 8, 10, 13, 14, 21, 23, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Konya, U.S. Patent No. 5,937,396.

Regarding to claim 8, Konya discloses an automated banking system for receiving payment from a user and for wire transfer of funds to a transferee in a banking network, said system comprising:

an automated machine having a card receiver for receiving a card which identifies the user as being qualified to use the banking network (*figure 2, column 9, lines 9-20, the ATM 14 includes a card reader 24, upon insertion of the transaction card 30 into the reader 24, the ATM 14 verifies an individual's access to the account encoded thereon*);

an input device to enter the amount to be transferred to another (*figure 2, column 8, lines 27-30, a plurality of function keys 22 for entering the amount; column 10, lines 28-35, entering amount to be transferred*);

a keypad to enter the identity of the transferee's account (*figure 2, column 8, lines 20-28, the keypad 20; column 10, lines 42-45, entering the transferee's account number using the keypad*);

a payment acceptor for accepting payment by the user for the wire transfer (*column 9, lines 9-20, the card reader 24 is also a payment acceptor to accept the*

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transaction card 30 for transferring the money from the user's account to the recipient's account);

a verifier to verify that the transferee has an account in the banking network (*column 10, lines 45-60, the recipient's account must be validated to ensure its existence*); and

a communication system having a modem in the banking network for wire transfer through the banking network to the verified transferee's account (*column 9, lines 57-65, modem 66*).

Regarding to claim 10, Konya further discloses wherein the payment acceptor comprises: a card receiver for receiving a card for payment for the wire transfer; and means for reading the card and for causing a debit on the card related to the cash being transferred by wire (*column 9, lines 9-20, the card reader 24 is also a payment acceptor to accept the transaction card 30 for transferring the money from the user's account to the recipient's account*).

Regarding to claim 13, Konya further discloses wherein: a printer prints a receipt for the sender of the wire transfer; and a transactional record system makes and keeps a record of the wire transfer (*column 8, lines 44-50, printing device is used to prepare a transaction report*).

Regarding to claim 14, Konya further discloses wherein an input device operable by the sender causes connection to the sender's withdrawal account to withdraw

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therefrom an amount sufficient to pay the wire transfer (*column 10, lines 28-40 and column 11, lines 1-10, amount transferred withdrawn from the user's account*).

Regarding to claim 21, Konya discloses a method of providing an automated banking system machine with the capability of wire transfer of funds from a user to a transferee within the banking network, comprising:

providing an automated machine having a card receiver for receiving a card which identifies the user as being qualified to use the machine and banking network (*figure 2, column 9, lines 9-20, the ATM 14 includes a card reader 24, upon insertion of the transaction card 30 into the reader 24, the ATM 14 verifies an individual's access to the account encoded thereon*);

putting into the machine an identification of the bank through which the transfer is to be made along with the account number of the transferee (*column 10, lines 42-45, entering the transferee's account number using the keypad*);

entering the amount to be wire transferred to the transferee (*column 10, lines 28-35, entering amount to be transferred*);

providing the machine with a method of payment for the wire transfer (*column 6, lines 17-25, input/output section 10 includes appropriate sources of input data for reading the appropriate card*); and

communicating through the bank system over a modem for wire transfer to the banking network to the verified transferee's account in the receiving bank (*column 9, lines 57-65, modem 66, communication through the bank system over a modem 66*).

Regarding to claim 23, Konya further discloses selecting payment for the wire transfer from a card; and reading the card and causing a debit on the card related to the amount of cash being wired to the transferee (*column 9, lines 9-20, the card reader 24 is also a payment acceptor to accept the transaction card 30 for transferring the money from the user's account to the recipient's account*).

Regarding to claim 26, Konya further discloses printing a receipt for the transactional cost of the wire transfer; providing the receipt to the user; and recording, internally within the machine, a transaction record of the wire transfer (*column 8, lines 44-50, receipt dispenser 28 functions with a printing device for printing a transaction report*).

Regarding to claim 27, Konya further discloses selecting payment from an account of the user; and connecting via a communication network, including a modem to the user's bank, to withdraw from the user's account, an amount sufficient to pay for the wire transfer transaction (*column 10, lines 28-40 and column 11, lines 1-10, amount transferred withdrawn from the user's account*).

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9, 11, 12, 15, 22, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konya, U.S. Patent No. 5,937,396, in view of Bator et al. (hereinafter Bator), U.S. Patent No. 6,575,362.

Regarding to claim 9, Konya does not disclose wherein the payment acceptor comprises a cash receiver for receiving and totaling the cash received. However, Bator discloses wherein the payment acceptor comprises a cash receiver for receiving and totaling the cash received (*column 6, lines 25-33, bill acceptor device 60 permits a customer to pay for a money order using cash*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using cash as a transferring method.

Regarding to claim 11, Konya does not disclose wherein the payment acceptor comprises a credit card reader which reads the credit card and performs a charge transaction over a credit card network for an amount related to the cash being wired. However, Bator discloses wherein the payment acceptor comprises a credit card reader which reads the credit card and performs a charge transaction over a credit card

network for an amount related to the cash being wired (*column 5, lines 40-50 and column 7, lines 1-10, a card reader 50 is provided for accepting payment by credit card*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using credit card as a transferring method.

Regarding to claim 12, Konya does not disclose wherein payment is made with a smart card; and a smart card reader and debit system reads the card to ascertain an amount on the card sufficient for payment of the cash being wired, and writes down the smart card by an amount related to the amount of cash being transferred by wire. However, Bator discloses wherein payment is made with a smart card; and a smart card reader and debit system reads the card to ascertain an amount on the card sufficient for payment of the cash being wired, and writes down the smart card by an amount related to the amount of cash being transferred by wire (*column 5, lines 40-65 and column 9, lines 40-60, payment is made with a smart card*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using smart card as a transferring method.

Regarding to claim 15, Konya does not disclose wherein a display displays to the user a method of payment from among cash, credit card, smart card or account withdrawal; and a selector is operable by the user to select one of the methods of payment for the wire transfer. Although, Bator does not directly disclose wherein a

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display displays to the user a method of payment from among cash, credit card, smart card or account withdrawal; and a selector is operable by the user to select one of the methods of payment for the wire transfer. However, Bator discloses wherein a display displays to the user a guiding instruction (column 11, lines 15-20), allows the user to transfer funds using a method of payment from among cash, credit card, smart card or account withdrawal (column 6, lines 65-67) and input/output section 10 for inputting customer selection of the transaction (column 5, lines 30-40 and column 6, lines 17-25). Thus, it would be obvious in Bator's that the input/output section 10 is operable by the user to select one of the methods of payment for the wire transfer in order to satisfy the feature of "transfer funds using a method of payment from among cash, credit card, smart card or account withdrawal" disclosed in Bator. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using a plurality of transferring methods from among cash, credit card, smart card or account withdrawal.

Regarding to claim 22, Konya discloses a transaction fees associated with the transfer (column 9, lines 30-32). Konya does not disclose depositing cash for the wire transfer; counting the cash received in the machine; and verifying it as being an amount to cover the wire transferred amount. However, Bator discloses depositing cash for the wire transfer; counting the cash received in the machine; and verifying it as being an amount to cover the wire transferred amount (*column 9, lines 60-67, the requested money order is only issued after a sufficient amount of actual money is deposited in the*

kiosk via a bill acceptor). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using cash as a transferring method.

Regarding to claim 24, Konya discloses the transactional fee which are to be charged to the user's account (column 9, lines 30-32). Konya does not disclose providing a card includes the use of a credit card; and further comprising communicating, over a credit card network, the amount of the cash being wired charged to the user's credit card. However, Bator discloses providing a card includes the use of a credit card; and further comprising communicating, over a credit card network, the amount of the cash being wired charged to the user's credit card (*column 5, lines 40-50 and column 7, lines 1-10, a card reader 50 is provided for accepting payment by credit card*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using credit card as a transferring method.

Regarding to claim 25, Konya does not disclose wherein the payment is being made with a smart card and further comprising: reading the smart card to ascertain if the amount on the card is sufficient for payment of the transaction including the cash being wired; writing down on the smart card the amount of the transaction for the wire transfer; and returning the smart card to the user. However, Bator discloses wherein the payment is being made with a smart card and further comprising: reading the smart card

to ascertain if the amount on the card is sufficient for payment of the transaction including the cash being wired; writing down on the smart card the amount of the transaction for the wire transfer (*column 5, lines 40-65 and column 9, lines 40-60, payment is made with a smart card*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using smart card as a transferring method.

Regarding to claim 28, Konya does not disclose wherein there is provided a display to the user requesting a selection for the method of payment from among the options of paying with cash, the user's credit card, a smart card, or withdrawal from the user's account; and the user selects one of the methods of payment for the wire transfer. Although, Bator does not directly disclose wherein there is provided a display to the user requesting a selection for the method of payment from among the options of paying with cash, the user's credit card, a smart card, or withdrawal from the user's account; and the user selects one of the methods of payment for the wire transfer. However, Bator discloses wherein a display displays to the user a guiding instruction (column 11, lines 15-20), allows the user to transfer funds using a method of payment from among cash, credit card, smart card or account withdrawal (column 6, lines 65-67) and input/output section 10 for inputting customer selection of the transaction (column 5, lines 30-40 and column 6, lines 17-25). Thus, it would been obvious in Bator's that the input/output section 10 is operable by the user to select one of the methods of payment for the wire transfer in order to satisfy the feature of "transfer funds using a

method of payment from among cash, credit card, smart card or account withdrawal" disclosed in Bator. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Konya's to incorporate the feature taught by Bator's above, for the purpose providing more convenient for the user to transfer funds using a plurality of transferring methods from among cash, credit card, smart card or account withdrawal.

Conclusion

11. Claims **8-15** and **21-28** are rejected.
12. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure:

Jennings et al. (US 5,825,003) disclose system and method for allowing funds to be transferred instantly to an account so that the funds are available to the beneficiary at the time they are sent.

Mori et al. (US 5,854,581) disclose a transaction processing system including a host computer (1), a transaction device (2), a first customer card (3) and a second customer card (4). The first card (3) and the second card (4) directly transfer information representing monetary values between them.

Elbaum (US 6,010,067) discloses mobile funds transaction device for transferring funds between remote banking facilities.

Gatto (US 6,149,055) discloses an electronic fund transfer (EFT) system capable of displaying a menu including one or more user-defined custom transactions

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associated with an identification card so that the user can select a desired transaction by a single selection or with limited inputs.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

July 15, 2008